

REMARKS

Claims 1-6 remain in this application.

Claim 1, as amended, calls for a single use self-contained surgical knife having a single blade, comprising: (i) containment means for housing said surgical knife blade; (ii) stabilization means having at least a pair of slot faces for preventing twisting of said blade; (iii) retraction means for exerting spring tension on said knife blade to move said blade into said containment means; (iv) locking means comprising a rectangular lug misaligned to a rectangular opening in a knurled ring member, for locking said knife blade in an ‘in-use’ position; wherein a user turns said knurled ring member after using said surgical knife in order to release the rectangular lug and retract the knife blade permanently into the said containment casing. The amendments to claim 1 are clearly supported by the specification, as originally filed. Accordingly, no new matter has been added.

Applicants’ invention provides a single use self-contained surgical knife that provides twist stability and lateral support for the knife blade. Turning a knurled ring member within the containment casing retracts the knife blade into the containment casing. Retraction of the blade is permanent; once retracted, subsequent usage of the knife blade is prevented. A substantial safety margin is provided, in that injuries occasioned by the retraction process are virtually eliminated. The knife blade remains forever in the retracted condition, preventing spread of blood borne infections such as

AIDS, Hepatitis and the like, that might otherwise result from subsequent usage of the knife blade.

35 USC § 101

The Examiner has rejected claims 1-5 under 35 USC § 101 as being directed to non-statutory subject matter.

The Examiner states that the “turning means for turning the knurled ring” was described in the specification as a surgeon (page 9, line 20). In order to overcome this rejection, claims 1-5 have been amended, in view of the Examiner’s comments. Claim 1, as amended, calls for a single use self-contained surgical knife having a single blade, ... wherein a user turns said knurled ring member after using said surgical knife in order to release the rectangular lug and retract the knife blade permanently into the containment casing. As amended, the “turning means” (i.e. surgeon) of original claim 1 has been replaced with a “wherein” clause, which recites the functionality resulting from the structural elements called for in the body of the claim. As amended, claims 1-5 no longer claim “turning means”, or a surgeon. In view of the amendments to claim 1 (and claims 2-5 dependent thereon), it is submitted that the rejection of these claims as being directed to non-statutory subject matter has been obviated.

Accordingly, reconsideration of the rejection of claims 1-5 under 35 USC § 101 as being directed to non-statutory subject matter is respectfully requested.

Drawings

The Examiner has objected to the drawings. Specifically, the Examiner has indicated that the drawings must show every feature of the invention specified in the claims. The Examiner has stated, therefore, that (i) “the bushings” and (ii) “the parallel slots” must be shown or the features canceled from the claims. The Examiner has indicated that no new matter should be entered.

Regarding “the bushings”, this feature has been canceled from the claims.

Regarding “the parallel slots”, it is submitted that the language of the claim element is “stabilization means *having at least a pair of slot faces* for preventing twisting of said blade”, and not “parallel slots”, as the Examiner has stated. Therefore, the following discussion addresses the issue of whether “a pair of slot faces” is shown in the drawings of record. Applicants respectfully submit that “a pair of slot faces” is clearly depicted in Figures 1a and 2a. Significantly, the pair of slot faces is positioned in intimate contact with both sides of the knife blade 12, respectively, and therefore cannot be shown as separate surfaces; it is because of this intimate contact that the knife blade is stabilized, to prevent it from twisting during use. Consequently, it is submitted that the surfaces that define the knife blade are the same surfaces that define the pair of slot faces. See especially applicants’ specification at page 9, line 24 to page 10, line 2; and page 10, lines 16-18. Therefore, it is respectfully submitted that it is at least inherent, if not explicit, to the drawings, as originally filed, that “a pair of slot faces” are shown.

Accordingly, reconsideration of the objections to the drawings as not showing every feature of the invention specified in the claims is respectfully requested.

35 USC § 112

Claims 1-6 were rejected under 35 USC 112, first paragraph, for failing to comply with the enablement requirement.

The Examiner has stated that claims 1-6 contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most clearly connected, to make and/or use the invention.

Regarding claims 1-5, the Examiner has stated that the specification fails to disclose lateral stabilization means having two shaft support bushings for supporting a shaft carrying a blade. Inasmuch as this feature has been canceled from claims 1-5, it is submitted that this rejection is now moot.

Regarding claim 6, the Examiner has stated that the specification fails to disclose how to apply pressure with a specialized tool. Inasmuch as this language has been canceled from claim 6, it is submitted that this rejection is now moot. Further, it is submitted that the understanding of how to compress a spring is well within the knowledge of the skilled art worker.

Accordingly, reconsideration of the rejection of claims 1-6 under 35 USC 112, first paragraph, for failing to comply with the enablement requirement is respectfully requested.

Conclusion

In view of the amendments to the claims and the remarks set forth above, it is respectfully submitted that the present application is in allowable condition. Reconsideration of the objections to the drawings and the rejection of claims 1-6, and allowance of this application, as amended, are earnestly solicited.

Respectfully submitted,
Edward Bilenski et al.


By _____
Ernest D. Buff
(Their Attorney)
Reg. No. 25,833
(908) 901-0220